APPENDIX

PATENT MARKING AND NOTICE STATUTE

It shall be the duty of all patentees and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented; either by fixing thereon the word "patent", together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is inclosed, a label containing the like notice: *Provided, however,* That with respect to any patent issued prior to April 1, 1927, it shall be sufficient to give such notice in the form following, viz.: "Patented," together with the day and year the patent was granted; and in any suit for infringement by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement and continued, after such notice, to make, use, or vend the article so patented. R. S. § 4900; 16 Stat. L. 203, as amended, c. 67, 44 Stat. L. 1058; 35 U. S. C. § 49.

IN THE UNITED STATES DISTRICT COURT

FOR THE SOUTHERN DISTRICT OF NEW YORK

ACTICARBONE CORPORATION,

Petitioner,

NATIONAL CARBON COMPANY, INC.,

Respondent.

EQUITY No. 82-97

Opinion

(Decided June 30, 1936)

KNOX, District Judge.

The petition for a declaratory judgment, when filed, was clearly defective in that it did not factually allege the existence of an actual controversy between the parties. Such defect, so far as Patent No. 1,497,543 is concerned, has been cured by the amendments to the original petition, subsequently filed. Nevertheless, the defect in respect to Patent No. 1,497,544 continues. Furthermore, the Court's jurisdiction of the subject matter of the petition having to do with the unfair competition charged against the respondent, there being no diversity of citizenship between the litigants, is of an extremely doubtful character. Each of these shortcomings, if such they be, can be cured by appropriate amendment. However, since the filing of the original petition respondent has asserted the rights it claims against petitioner in an ordinary patent suit. In that action the disputes of the parties may be determined. Having regard for the fact that all the issues there to be tried will be actual, and wholly unincumbered by the presence of a number that may be merely academic, I have concluded, in the exercise of discretion, to dismiss the petitioner and its amendments, and require the controversies to be presented in the suit in which respondent is complainant. In this connection it may be observed that local equity rule No. 2 will be applicable to the infringement suit, if respondent should undertake to discontinue the same.